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IN THE

# Supreme Court of the United States

**October Term, 1973**

**No. 73-454**

PHILLIPS PETROLEUM COMPANY,
*Petitioner,*

vs.

KARL ZIEGLER,
*Respondent.*

## BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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## REASONS FOR DENYING THE WRIT

### 1. Petitioner's Question is not Presented for Review.

The question allegedly presented to this Court for review is whether the federal courts in infringement litigation may properly disregard restrictive meanings of Patent Office terms of art. Specifically, petitioner alleges that the phrase "essentially consisting of", appearing in a claim, is a term of art as used by the Patent Office, having a restrictive meaning, and that the Court of Appeals for the Fifth Circuit disregarded this "restrictive meaning."

Petitioner argues that the "essentially consisting of" claim language, appearing in the '115 patent, restricts the claim to a catalyst containing components "A" and "B"[1] and only such additional components which would not materially affect the basic and novel characteristics or the fundamental character of the material.

In finding infringement of the '115 claims by petitioner, Phillips Petroleum Company (Phillips), it was exactly this construction and meaning that the Court of Appeals for the Fifth Circuit gave to the claims of the '115 patent. The Court of Appeals found that while the accused Phillips' catalyst may contain a third component "C,"[2] that third component would not alter the fundamental polymerization action of the Ziegler components, *i.e.*, the components called for in the claim of the '115 patent. Moreover, the Court of Appeals concluded that the basic and fundamental polymerization action of Phillips' catalyst was completely dependent on the presence of components A and B (App. 33a).

The Court of Appeals, thus, found infringement on the basis that the accused Phillips catalyst contains the two components (A and B) which the claimed catalyst was recited as "essentially consisting of", and did not contain any additional or third component which changed the fundamental character of the two recited components or which would materially affect the basic and novel characteristics of the composition formed from the two recited components.[3] *Petitioner's question is therefore not presented for review.*

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[1] Diethyl aluminum chloride and a titanium chloride salt.

[2] Aluminum trichloride.

[3] The Court specifically recognized that:

"at no time did anyone ever testify that the addition of the aluminum trichloride altered the fundamental polymerization action of the Ziegler components." (*Ibid.*)

Furthermore, the Court of Appeals found that the Phillips catalyst containing the third component C was the equivalent of the '115 patent's catalyst, *i.e.*, that the catalyst formed of A, B and C was the full equivalent of the catalyst formed of A and B. (*Ibid.*) If a catalyst containing the third component C is a full equivalent of a catalyst without this component, the addition of this third component obviously cannot materially affect the basic and novel characteristics of the A + B catalyst composition. There thus is no enlargement of the allegedly restrictive meaning of the Patent Office term of art "essentially consisting of" which would raise the question presented for review

**2. The Question Was Not Presented *by* Petitioner In The Lower Courts.**

**a. Petitioner Failed to Timely Raise the Instant Question In the Court of Appeals.**

In the court below, petitioner did not timely raise the point set forth in its Petition for Certiorari. At best it argued that "the essentially consisting" language should be narrowly construed in view of an *alleged file wrapper estoppel*. Nowhere in its main brief before the Court of Appeals did Petitioner even refer to *Ex parte Davis*, 80 U. S. P. Q. 448 (P. O. Bd. App. 1948), the Patent Office Board of Appeals case now deemed so pertinent.

The Court of Appeals rejected Phillips' argument that there was a file wrapper estoppel, noting that Phillips "failed to show anything in the file wrapper that indicated that third components were being excluded . . . ." (App. 30a). Since Phillips has failed to challenge this ruling of the Court of Appeals in its petition, its argument relating to alleged limitations in the claim language is not properly before this court.

**b. The Record Is Insufficient to Show any Uniform Vocabulary in the Patent Office.**

Petitioner has not offered even a scintilla of evidence in the record showing that a uniform vocabulary of expression has been adopted by the Patent Office or that the terminology in question constitutes a recognized part thereof. Petitioner has not shown that such a vocabulary or the phrase in question has been incorporated in the Rules of Practice before the United States Patent Office, which the Commissioner of Patents is authorized to promulgate. Nor has the petitioner shown that this vocabulary or a suggestion or instructions to use the same has been incorporated in the Manual of Patent Examining Procedure, which provides the guide and standard of the Patent Examining Corps for examining and acting on patent applications. Indeed, neither this so-called uniform vocabulary nor the language in question is mentioned in either of these Patent Office publications.

To the contrary, petitioner relies on a Board of Appeals decision, a quarter of a century old, which simply notes that a *group* of Primary Examiners in the Patent Office at that time had adopted a code of terms for their *own* guidance.

Nor is petitioner's abortive attempt to supplement the record at this late date by the material appearing on pp. 50a, 51a and 59a of the Petition meaningful or helpful to them. This material is not proper evidence in the record, and apart from its inadmissibility, is obviously meaningless on its face. Clearly, this Court is most competent to interpret the meaning and holding of a legal decision without the guidance or explanations of the Acting Solicitor of the Patent Office.

**The fact that the *Davis* decision might be commented on in some way or other in the lectures given to Patent Examiners by the Patent Office Academy establishes nothing in the absence of evidence in the record below establishing the scope and content of the comments and the relevancy of the Patent Office Academy and its lecture series to the petitioner's allegations that the Patent Office has adopted a uniform vocabulary of expressions, of which the expression in question is a part.**

**3. Even if Properly Presented for Review, the Question Would Not be of Sufficient Importance to Warrant Consideration by this Court.**

Even utilizing the petitioner's self-serving statistics, *which have not been established in the record of this case*, the language in question would not be applicable to more than about one percent of the issued patents.[4] Nor has it or can it be shown that even a minor problem exists or is likely to arise in connection with the exercise by the Federal Courts of their traditional and time-honored role of construing patents and patent claims in infringement actions.[5]

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[4] At present, there are well over three and a half million patents, and claims for infringement may still be brought on approximately one and one quarter million patents. 35 U. S. C. §§ 154, 286; see 638 O. G. 90 (1950) and 914 O. G. 380 (1973).

[5] Petitioner has failed to cite a single case where the question of *infringement* of a claim in the form "essentially consisting of" was decided. In *Allied Research Products, Inc. v. Heathbath Corp.*, 161 U. S. P. Q. 527 (N. D. Ill. 1969), however, a case in which the composition claims were apparently in that form, the court stated:

> "The fact that claims 3, 6, 16 and 17 relate to a coating composition in which the essential coating producing ingredients are the three-component system made up of a chromium, a fluorine and a ferricyanide compound, does not exempt the accused Alchrome products that contain an additional component. Such additional component has been shown to be incapable of *radically modifying* the basic and novel character of the claimed composition and one does not escape infringement in this manner." *Id.* at 542 (emphasis added)

This Court has more important matters to decide and would not be warranted in expending its valuable time in determining the extent to which the Federal Courts should be bound and limited by what certain groups of Patent Examiners might do for their own guidance.

## Conclusion

For the reasons above, the Court should deny the petition.

Respectfully submitted,

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